



Attorney Docket No.: C069

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**APPLICATION NO.:** 10/673,674

**APPLICANT:** Michael D. Hitchcock

**FILING DATE:** 09/29/2003

**TITLE:** Universal Forms Engine

**INFORMATION DISCLOSURE STATEMENT**

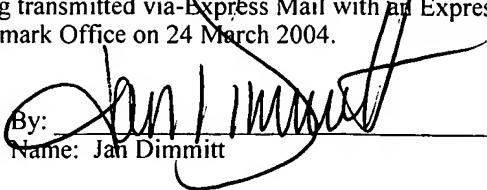
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Pursuant to the guidelines for Information Disclosure Statements, 37 C.F.R. §§ 1.97-1.98, attached hereto is PTO Form 1449 (three sheets) with references listed for consideration by the Office. Copies of cited US patents are not provided in accordance with the waiver published in the August 5, 2003 Official Gazette. References cited in parent applications are to be reviewed by the Examiner in accordance with MPEP 707.05 and are not separately listed.

In accordance with 37 C.F.R. §§ 1.97(g)-(h), the filing of this Information Disclosure Statement shall not be construed as a representation that a search has been made or an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in 37 C.F.R. § 1.56(b).

**CERTIFICATE OF EXPRESS MAILING**

I hereby certify that this paper or fee is being transmitted via Express Mail with an Express Mail No.: ER 437384888 US to the United States Patent and Trademark Office on 24 March 2004.

By:   
Name: Jan Dimmitt

Application No.: 10/673,674

Filing Date: 09/29/2003

Information Disclosure Statement dated March 24, 2004

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This Information Disclosure Statement is being filed before the mailing of a first Office action on the merits.

In compliance with MPEP 2001.06(b), applicants wish to make the Examiner aware of related pending US. Pat. Apps. No. 10/714,547 and 10/714,493.

In compliance with MPEP 2001.06(c), applicants wish to inform the Examiner that US Pat. Nos. 6,345,278 and 6,640,042, which issued from applications in the priority chain of the present application, were litigated against ApplyYourself, Inc. (US District Court for the District of Oregon, Civil Docket No. CV-02- 484 HU and CV-02-1359 HU). That case is currently on appeal. (Federal Circuit Appeal No. 04-1202).

During the litigation, the defendant ApplyYourself, Inc. unsuccessfully asserted that the asserted claims of both patents were invalid for obviousness and for on-sale activities by XAP Corporation. ApplyYourself, Inc. withdrew the assertion of invalidity as to US Pat. No. 6,640,042 before submission to the jury and the jury found the asserted claims of US Pat. No. 6,345,278 to be valid. To ensure compliance with their duty of disclosure, with regard to the XAP Corporation activities, applicants hereby provide various documents from the litigation, including trial testimony of Mr. Allen Firstenberg of XAP Corporation, trial and deposition testimony of Mr. Frank Tansey, formerly of Sonoma State University, and deposition testimony of Mr. James L. Maraviglia of California Polytechnic State University. Attached to the Maraviglia deposition as an exhibit is a copy of a Contract No. A960014 between XAP Corporation and the Trustees of the California State University. Other documents produced during the litigation and not sealed by the court are included as items PP, QQ, and RR on the attached form PTO/SB/08B.

Additional documents that are described in the testimony are under seal by order of the court at the insistence of XAP Corporation, which refuses to make the additional documents available for submission to the PTO. The attached Contract No. A960014 was obtained from the State of California through a Freedom of Information Act request.

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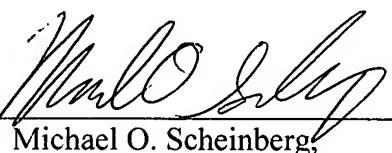
Applicants also submit a copy of an October 12, 2001 Declaration of James H. Wolfston, Jr., which was submitted in previous applications in the priority chain, describing assignee's ApplyWeb I system. Additional research undertaken for the recent litigation has revealed that the date on which ApplyWeb I system was placed on the Internet was probably closer to July 1996, rather than September 1995. Because the July 1996 date is later, and both dates are before the critical date, applicants submit the error is not material and have not required a new Declaration from the Declarant.

In compliance with MPEP 2001.06(c), applicants also disclose that the patent owner has a pending patent infringement action against XAP Corporation (US District Court for the District of Oregon, Civil Docket No. 03-01229-HU). The patent owner filed, but has since dismissed without prejudice, a patent infringement action against Princeton Review (US District Court for the District of Oregon, Civil Docket No. 03-01231-HU).

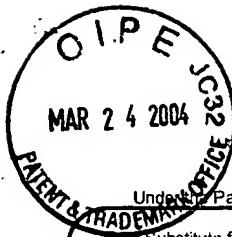
Respectfully submitted,

Date: 3/24/04

By:



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Substitute for form 1449/PTO

## INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Use as many sheets as necessary)

Sheet

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of

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**Complete if Known**

Application Number	10/673,674
Filing Date	09/29/2003
First Named Inventor	Michael D. Hitchcock
Art Unit	
Examiner Name	

Attorney Docket Number C069

**U. S. PATENT DOCUMENTS**

Examiner Initials*	Cite No. <sup>1</sup>	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code <sup>2</sup> (if known)			
A	US- 6,279,112 B1		08-21-2001	O'Toole, Jr. et al.	
B	US- 6,189,029		02-13-2001	Fuerst	
C	US- 6,141,666		10-31-2000	Tobin	
D	US- 6,122,657		09-19-2000	Hoffman, Jr. et al.	
E	US- 6,058,373		05-02-2000	Blinn et al.	
F	US- 6,035,276		03-07-2000	Newman et al.	
G	US- 5,987,480		11-16-1999	Donohue et al.	
H	US- 5,983,227		11-09-1999	Nasem et al.	
I	US- 5,897,622		04-27-1999	Blinn et al.	
J	US- 5,872,640		02-16-1999	Cohen et al.	
K	US- 5,845,075		12-01-1998	Uhler et al.	
L	US- 5,835,712		11-10-1998	DuFresne	
M	US- 5,819,287		10-06-1998	Tsuoka	
N	US- 5,774,670		06-30-1998	Montulli	
O	US- 5,761,673		06-02-1998	Bookman et al.	
P	US- 5,734,887		03-31-1998	Kingberg et al.	
Q	US- 5,717,923		02-10-1998	Dedrick	
R	US- 5,715,453		02-03-1998	Stewart	
S	US- 5,704,029		12-30-1997	Wright, Jr.	

**FOREIGN PATENT DOCUMENTS**

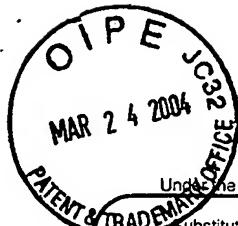
Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages Or Relevant Figures Appear	T <sup>6</sup>
		Country Code <sup>3</sup> -Number <sup>4</sup> -Kind Code <sup>5</sup> (if known)				

Examiner Signature	Date Considered
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup>Applicant's unique citation designation number (optional). <sup>2</sup>See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup>Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup>For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup>Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>6</sup>Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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T	US- 5,563,999	10-08-1996	Yaksich et al.		
U	US- 5,455,948	10-03-1995	Poole et al.		
V	US- 5,410,675W	04-25-1995	Shreve et al.Y		
X	US- 5,367,619	11-22-1994	Dipaolo et al.		
Y	US- 5,325,478	06-28-1994	Shelton et al.		
Z	US- 5,319,542	06-07-1994	King, Jr. et al.		
AA	US- 5,187,787	02-16-1993	Skeen et al.		
BB	US- 5,129,086	07-07-1992	Coyle, Jr. et al.		
CC	US- 5,077,666	12-31-1991	Brimm et al.		
DD	US- 4,992,940	02-12-1991	Dworkin		
EE	US- 4,831,526	05-16-1989	Luchs et al.		
FF	US- 4,799,156	01-17-1989	Shavit et al.		
GG	US- 4,645,873	02-24-1987	Chomet		
HH	US- 6,421,693	07-16-2002	Nishiyama et al.		
II	US- 6,247,029	06-12-2001	Kelley et al.		
	US-				

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PTO/SB/088 (08-03)

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### NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
	JJ	S. BING YAO et al., "Formanager: An Office Forms Management System," ACM Transactions on Office Information Systems, Vol. 2, No. 3, July 1984, pages 235-262.	
	KK	D. TSICHRITZIS, "Operations and Management-Form Management," Communications of the ACM July 1982, Vol. 25, No. 7, pages 453-478.	
	LL	August 30, 2003 Telephonic Deposition of Frank Tansey, CollegeNET, Inc. v. Apply Yourself, Inc., US District Court for the District of Oregon, No. 02-CV-0484-HU	
	MM	June 18, 2003 Deposition of James L. Maraviglia, CollegeNET, Inc. v. Apply Yourself, Inc. US District Court for the District of Oregon, No. 02-CV-0484-HU, including exhibits not sealed by the court	
	NN	September 2, 2003 trial testimony of Frank Tansey, CollegeNET, Inc. v. Apply Yourself, Inc. US District Court for the District of Oregon, No. 02-CV-0484-HU	
	OO	Ausust 28, 2003 trial testimony of Allen Firstenberg, CollegeNET, Inc. v. Apply Yourself, Inc., US District Court for the District of Oregon, No. 02-CV-0484-HU	
	PP	"A Proposal for the Development and Operation of CSU TeachNet's Online Admission Application Process." Oct. 28, 1998 (CNA07672-CNA7690)	
	QQ	Contract Number A960014 Amendments 4-11, between California State University and XAP Corporation, dated between Feb 3, 1999 to June 25, 2002 (CNA07691-CNA07710) (Original Contract A960014 and amendment 3 included in ref. MM )	
	RR	XAP Corporation Press Release, "XAP Corporation Awarded Contract to Develop State of the Art Student Processing System for the Nation's Largest State- College System, Feb. 12, 1997	

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